

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Roger Q. SMITH**

Serial No.: 09/153,621 ✓

Examiner: **T. Dinh**

Filed: **September 15, 1998**

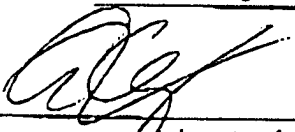
Group Art Unit: **2841**

For: **HEAVY-DUTY AUDIO EQUIPMENT**

Assistant Commissioner for Patents
Washington, DC 20231
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REQUEST FOR RECONSIDERATION

I, Adan Ayala, Reg. No. 38,373, certify that this
correspondence is being facsimile transmitted to the
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on 1-22-02 ✓ ₉₃₈₂



Adan Ayala

Dear Sir:

This is in response to the final Office Action mailed January 14, 2002.

Currently in the application are Claims 1-6 and 15-20.

The Examiner has rejected Claims 1-6 under 35 USC § 103(a) as being unpatentable over US Patent No. 2,058,407 ("Brown") in view of US Patent No. 5,669,323 ("Pritchard").

This rejection is respectfully traversed.

Claim 1 calls for an audio equipment comprising a housing, an audio circuitry installed within the housing, and a first protective bar flexibly connected to the housing.

Admittedly, Brown discloses a housing containing audio circuitry, and that the housing is connected to a leg assembly 14,15. However, this leg assembly is neither the

protective bars called for in Claim 1, nor flexibly connected to the housing. The Examiner relies on Pritchard to provide the flexible connection assembly.

The Examiner cannot combine Brown with Pritchard for three reasons. First, Pritchard is not analogous art. Second, no motivation or suggestion to combine Brown with Pritchard exists. Third, even if combined, the Brown/Pritchard device would not have all claimed elements.

As to the first reason, Applicant asked for any evidence showing that a person of ordinary skill, seeking to solve a problem of protecting a radio, would reasonably be expected or motivated to look for flexible connections in automatic bailers for canoes. The Examiner has presented no further evidence, other than a counter-argument that Pritchard discloses a flexible connection between a pump and a power supply, and thus it teaches a flexible connection between two parts. "[H]ence, Pritchard is an analogous art."

In other words, the Examiner is arguing that Pritchard is analogous regardless of its field. This reasoning is prohibited by the CAFC. In *Oetiker*, the CAFC held the reference was not within the field of applicant's endeavor, and was not reasonably pertinent to the particular problem with which the inventor was concerned because it had not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments. Similarly, the Examiner has provided no evidence that a person of ordinary skill, seeking to solve a problem of protecting a radio, would reasonably be expected or motivated to look for flexible connections in automatic bailers for canoes.

Accordingly, Applicant hereby renews his request that the Examiner provide any evidence so that Applicant can fully prepare his argument for an appeal to the

Board. If the Examiner cannot do that, Applicant requests that the application be allowed.

As to the second reason, Applicant pointed out that "if [a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP § 2143.01, at 2100-124 (*citing In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). Because the Examiner's proposed modification of replacing replace Brown's pivotable connection 16 with Pritchard's the flexible connection assembly 28 would render Brown, the prior art invention being modified, unsatisfactory for its intended purpose, i.e., maintaining the radio cabinet in a desired tilted position. (See Brown, col. 2, lns. 38-51.) Furthermore, Applicant argued that no suggestion to combine or modify Brown with Pritchard exists because the modification would change the principle of operation of Brown under MPEP § 2143.01, at 2100-125.

The Examiner has counter-argued that:

applicant recites a connector assembly 30 in page 4 of the specification (disclosed in figure 4), which is flexible [sic] connecting to a protective bar and a housing, and also in applicant's previous amendment filed on October 01, 2001 emphasized mention [sic] in page 2 that "As mentioned above .. when radio 10 is dropped." Applicant being claimed [sic] a protective bar (but not flexible_ connected to a housing by a flexible connection, which is a flexible connector assembly 30. In combine [sic] of argument (1), Brown in view of Pritchard disclose a leg 14 capable of being a protective bar connected to a housing (1,2) by a flexible connector assembly (28) of Pritchard.

With all due respect, this counter-argument does not address the Applicant's arguments. The Examiner has not discussed (1) why MPEP § 2143.01 is inapplicable, (2) how combining Brown with Pritchard would not render Brown unsatisfactory for its intended purpose, i.e., maintaining the radio cabinet in a desired tilted position, or (3)

how combining Brown and Pritchard does not the principle of operation of Brown. It appears that the Examiner's counter-argument is that a suggestion to combine Brown and Pritchard exists because they are capable of being combined. This violates MPEP § 2143.01 that reads: "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP §2143.01, at 2100-124 (*citing In re Mills*, 916 F.2d 680 (Fed. Cir. 1990)).

In view of the Examiner's failure to address Applicant's arguments, **Applicant hereby requests a full response to Applicant's arguments so that Applicant can address the Examiner's counter-arguments in an appeal to the Board. If the Examiner cannot do that, Applicant requests that the application be allowed.**

Applicant's last argument was that, even if Brown and Pritchard are combined, the combination does not teach all the claimed elements, including "a protective bar." Applicant noted, for example, that, in Brown, the leg assembly does not serve to protect the radio, contrary to the Examiner's allegations. Applicant asked the Examiner to show how the leg assembly is "protective." The Examiner responded: "Regarding to argument (3), [sic] combination of (1) and (2), [sic] Brown in view of Pritchard would teach all of the limitation of claimed invention."

With all due respect, this counter-argument does not address how the leg assembly is a protective bar. If the Examiner truly believes the leg assembly is a protective bar, the Examiner should be able to point out something in the specification that shows his allegation. In view of the Examiner's failure to address Applicant's arguments, **Applicant hereby requests that the Examiner show how Brown's leg assembly is protective so that Applicant can address the Examiner's counter-arguments in an appeal to the**

Board. If the Examiner cannot do that, Applicant requests that the application be allowed.

In view of the foregoing, all the claims are patentable and the application is believed to be in condition for formal allowance. Reconsideration of the application and allowance of Claims 1-6 and 15-20 are respectfully requested.

No fee is due for the present amendment. Nevertheless, the Commissioner is authorized to charge payment of any fees due in processing this response, or credit any overpayment to Deposit Account No. 02-2548.

Respectfully submitted,



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TRANSMITTAL FORM

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Application Number	09/153,621
Filing Date	September 15, 1998
First Named Inventor	Roger Q. Smith
Group Art Unit	2841
Examiner Name	T. Dinh
Attorney Docket Number	TN-1444

Total Number of Pages in This Submission

ENCLOSURES (check all that apply)

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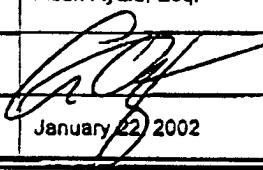
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Request for Reconsideration |
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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Adan Ayala, Esq.
Signature	
Date	January 22, 2002

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